

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of : KELLY, Paul et al
Serial No. : 09/740,201
Filed : December 18, 2000
For : Allocation Of Location-Based Orders To Mobile Agents
Examiner : BOYCE, Andre D.
Art Unit : 3623
Confirmation No. : 4327
Docket No. : 920673-907251

**SUCCINT STATEMENT IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Honorable Director of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The following is the applicant's statement in support of an appeal brief conference for this application.

The rejection of claims 1 and 23, as set forth in the Response of August 2, 2010, under 35 USC § 101 is submitted to be clearly improper for the following reasons:

1. "Machine or Transformation" test is improperly used as the exclusive test

The only rationale which has been given in support of the rejection of Claims 1 and 23 is an alleged failure to meet the "Machine or Transformation" test. A brief synopsis of the arguments made to date under Section 101 demonstrates that this test has been used as the sole rationale to support the rejection at all times. A rejection made solely on this basis is of course improper in the light of the decision of the Supreme Court in *Bilski v Kappos*, 130 S.Ct. 3218, 95 USPQ2d 1001 (2010).

(a) This rationale for rejection was first set out in the BPAI decision dated November 6, 2009, and then repeated in the Non-Final Office Action dated March 1, 2010. Both of these decisions were of course issued prior to the decision of the Supreme Court in *Bilski v Kappos* and therefore were proper based on the understanding of the law as it then stood.

(b) Following the issuance of the Supreme Court decision, Applicants pointed out in their Response filed August 2, 2010 that it was now improper to use the “Machine or Transformation” test as the sole or exclusive enquiry for patent eligibility. In recognition of the broader question of whether or not a method claim was directed to an abstract idea, seven specific arguments were provided (see page 12 of the Response of August 2, 2010) as to why the claims did not merely embrace an abstract idea. In this regard, detailed reliance was placed on the factors set out in the Office’s *July 2010 Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos*. Those arguments have never been addressed by the Examiner.

(c) In the Final Office Action dated October 14, 2010 the Examiner made a passing reference to the *Bilski* decision but did not in any way modify or depart from the previous approach of exclusive reliance on the “Machine or Transformation” test. Indeed, as can be seen from the first paragraph in the quotation of the rejection below, in fact it is now argued that the rationale for rejecting a claim *is* the “Machine or Transformation” test, and in the second quoted paragraph, this test is presented in mandatory terms:

Based upon consideration of all of the relevant factors with respect to the claim as a whole, claim(s) 1-23 are held to claim an abstract idea, and is/are therefore rejected as ineligible subject matter under 35 U.S.C. 101 *Bilski v. Kappos*, 95 USPQ2d 1001 (U.S. 2010). **The rationale for this finding is explained below:**

In order for a method to be considered a "process" under §101, **a claimed process must either:** (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. [emphasis added]

It is submitted that the references in the first paragraph to an “abstract idea” and to *Bilski* appear to have been included as mere formalities, and it is impossible to detect any suggestion that the former approach of relying exclusively on the “Machine or Transformation” test has changed. The conclusion in the first quoted paragraph above is explicitly stated to be justified by the rationale in the second quoted paragraph, which in turn clearly states that a process **must** meet the “Machine or Transformation” test to qualify under section 101. This means that the claims are rejected as failing to meet the mandatory standard set out in that test, which is clearly an improper rejection.

In case it might somehow be argued that despite what was said in the Final Office Action, other considerations were involved, it is noted that Applicants' specific arguments addressing the issues set out in the *July 2010 Interim Guidance* (the seven numbered paragraphs on page 12 of the August 2, 2011 Response) are not in any way rebutted or even mentioned in the Final Office Action.

(d) Applicants again highlighted the fact that the rejection was improper for solely relying on the "Machine or Transformation" test in the Response filed December 9, 2010 (see pages 12 and 13 of that Response), and the positive arguments in favor of finding that there is more than an abstract idea were again reiterated (see the seven numbered points on pages 14 and 15 of the December 9, 2010 Response).

(e) Finally, the Advisory Action dated January 20, 2011, again provided no explanation as to why the sole rationale for rejection continues to be the "Machine or Transformation" test. It provided no alternative to that test. It provided no rebuttal or consideration of the broader arguments submitted in favor of finding that there is more than an abstract idea based on other factors. Indeed, the explanatory statement on the Continuation Sheet of the Advisory Action only serves to further emphasize the apparent essentiality of the "Machine or Transformation" test by explaining why the recitation of a particular machine or a transformation of an article is considered to be insufficient, nominal or tangential – these being hallmarks of a rejection which is based solely on that test.

Accordingly, the rejection of claims 1 and 23 (and hence also each dependent claim) is improper because it relies solely and exclusively, on each occasion that the argument has been made or explained, on the "Machine or Transformation" test. No other rationale for rejection has ever been offered by the Examiner, and no consideration has been given to the repeated presentation of additional factors which are indicative that the claimed method goes beyond a mere abstract idea, e.g. the arguments on page 12 of the Response filed on August 2, 2010.

2. Elements originally found in claim preamble not given patentable weight

The Final Office Action dated October 14, 2010 refused to accord patentable weight to the recitation of the "method being carried out by an ordering server programmed to carry out the steps of the method", due to this recitation being in the preamble.

Whether to treat a preamble term as a claim limitation is "determined on the facts of each case in light of the claim as a whole and the invention described in the patent." *Storage Tech. Corp. v. Cisco Sys., Inc.*, 329 F.3d 823, 831 (Fed. Cir. 2003). The preamble may be construed as limiting "if it recites essential structure or steps, or if it is 'necessary to give life, meaning, and vitality' to the claim." *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002), quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). The

recitation of the ordering server in the preamble of claim 1 clearly gives life, meaning and vitality to the claim.

The Advisory Action states that the discussion of the preamble in the Final Office Action remains applicable. It is submitted that the rejection, as explained in the Advisory Action, is in error because it apparently refuses to accord patentable weight to the recitation of the ordering server in the preamble (i.e. saying this discussion remains applicable).

3. Both branches of “Machine or Transformation” test are satisfied

Without prejudice to the first argument above (i.e. the “Machine or Transformation” test is not the sole or exclusive test for patent eligibility), Applicants submitted detailed reasons in the response filed August 2, 2010 as to why claims 1 and 23 in fact satisfy **both** branches of that test, this being further indicative of patent eligibility.

Pages 10-12 of the Response provided detailed justification for considering the method to be tied to a “particular machine” in more than a merely nominal, insignificant or tangential way. Furthermore, there are two separate and distinct transformations of “articles” occurring in the methods of claims 1 and 23, each of which alone would suffice to satisfy the test. The articles in question are (1) the ordering server, and (2) data representing agents and locations. How these articles are transformed and the significance of this transformation again leaves it beyond doubt that there is more than a merely nominal, insignificant or tangential transformation.

Were this not enough, a simple review of the claims makes it quite clear that the transformation branch is amply met. Subparagraph b) of claims 1 and 23 requires prioritizing based on scheduled and unscheduled locations as a function of the availability of an agent, a clear meeting of the transformation branch. Subparagraph d) of claim 1 requires determining a suitable agent as a function of the agent’s availability, and subparagraph c) of claim 23 requires an updating an order record and identifying a new first location as a function of the update. These elements all clearly represent transformations that satisfy section 101.

It is therefore submitted that the rejection of claims 1 and 23 clearly errs in failing to recognize that these methods are tied to a particular machine and require significant transformation. Any single one of these factors would be enough on its own to satisfy the test.

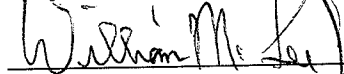
The Examiner has no counter argument. Once a particular machine or a transformation is identified, the only possible objection remaining to an Examiner under the “Machine or Transformation” test is that the involvement of these elements is “merely nominal, insignificant or tangential”. If such an argument is made, it needs to be explained. Simply repeating a formula of words does not make it so, and does not constitute a valid rebuttal which can justify the conclusion.

In the Advisory Action dated January 20, 2011, however, the Examiner has done just that, stating without any supporting reasoning that the machine/transformation elements are “merely nominal, insignificant or tangential”. That conclusion, without reasoning, carries no persuasive weight and is overwhelmingly contradicted by the fact that the ordering server and the data in question are inextricably linked with the claimed method steps in a significant and tangible manner. Accordingly, Applicants have indeed satisfied both branches of the “Machine or Transformation” test, and the continued rejection of the claims with reference to this test is in error.

It is therefore submitted that the Examiner’s rejections under 35 U.S.C. § 101 are untenable, and were this application to proceed to the Board of Appeals and Interferences, the Examiner would be reversed. The results of this review are therefore awaited.

February 18, 2011

Respectfully submitted,



William M. Lee, Jr.
Registration No. 26,935
Barnes & Thornburg LLP
P.O. Box 2786
Chicago IL 60690-2786
(312) 214-4800
Fax (312) 759-5646